

## REMARKS

### STATUS OF THE CLAIMS

No claims have been amended. Claims 49 – 51, 56 – 58, 67, 69 – 72, 75, and 76 are pending and at issue.

### RESTRICTION REQUIREMENT

Applicant notes the Examiner's acknowledgement of the election of the species of heteromeric receptor comprising SEQ ID NO:8 (mouse T1R2) and SEQ ID NO:20 (mouse T1R3).

### REJECTION UNDER 35 U.S.C. § 102

Claims 49, 50, 51, 56, 57, 58, 67, 69-72 and 75 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by US Patent Publication 20030232407 to Zoller et al, published December 18, 2003 ("Zoller"). Applicant respectfully disagrees with this rejection and respectfully requests clarification of the rejection from the Examiner. Zoller does not appear to include the element of "wherein the T1R2 polypeptide has a greater than 90% amino acid sequence identity to SEQ ID NO: 7 or 8" (where the elected species in SEQ ID NO:8) and/or this element is not entitled to a priority date that is before that of the instant application.

First, the Examiner stated that "the rT1R2 disclosed by Zoller is 100% identical to the instant SEQ ID NO:7." However, a SEQ ID NO corresponding to a rat T1R2 sequence cannot be located in Zoller. Applicant respectfully requests that the Examiner more specifically identify the disclosure of the rat T1R2 sequence in Zoller.

Second, although the Examiner compared an unidentified rat T1R2 sequence to the rat T1R2 sequence of the instant application, the Examiner did not provide a comparison of Zoller's rT1R2 sequence and the elected mouse T1R2 (SEQ ID NO:8) of the instant application. Therefore it is unknown if Zoller's rT1R2 sequence has a greater than 90% amino acid sequence identity to SEQ ID NO: 8. If possible, Applicant respectfully requests that the Examiner provide a sequence comparison between Zoller's rT1R2 sequence and the elected mouse T1R2 (SEQ ID NO:8) of the instant application.

Lastly, as described in more detail below disclosure of rT1R2 does not appear to be supported in the provisional applications to which the Zoller application claims priority and which predate the instant application. The examiner has not carried the initial burden of showing that Zoller is available as a prior art reference – a necessary element to the examiner's prima facie case of unpatentability.

Zoller was filed after the instant application, but claims the benefit of eight (8) provisional applications, four (4) of which were filed before the present application. In citing Zoller, therefore, the examiner has to assume the reference is entitled to an earlier effective date due to its benefit claim. But before the examiner can accord Zoller that earlier effective date, two requirements must be met: First, the examiner must show that the subject matter relied on in the rejection is also found in the earlier provisional application. A patent that claims the benefit of a provisional application may be accorded the earlier filing date as its effective date under 35 U.S.C. § 102(e) only if the subject matter used to make the rejection is appropriately supported in that provisional application. *In re Lund*, 376 F.2d 982, 987-88 (C.C.P.A. 1967) (refusing to apply disclosure that was not carried forward from parent application); see also MPEP 706.02(f)(1) (instructing examiner, when determining the effective date of a reference, to consider benefit claims to prior applications under 35 U.S.C. 119(e) or 120 "if the prior application(s) properly supports the subject matter used to make the rejection").

Secondly, the examiner must show that Zoller's claims are supported under 35 U.S.C. § 112 by the provisional application. As the courts have explained:

If . . . the PTO wishes to utilize against an applicant a part of that patent disclosure found in an application filed earlier than the date of the application which became the patent, it must demonstrate that the earlier-filed application contains . . . support for the invention claimed in the reference patent. For if a patent could not theoretically have issued the day the application was filed, it is not entitled to be used against another as 'secret prior art' . . . .

*In re Wertheim*, 646 F.2d 527, 537 (C.C.P.A. 1981); see also MPEP 2136.03. To establish a prima facie case of unpatentability, therefore, the examiner must show (1) that all of the subject matter relied on in the rejection is also found in the provisional application, and (2)

that Zoller's claims are supported by the earlier provisional application. Because the examiner has not carried this initial burden, Zoller cannot be treated as prior art under 35 U.S.C. § 102(e).

Should the examiner maintain this rejection based on Zoller, Applicant requests that the Examiner identify the subject matter in the provisional application - not the published application - that the examiner asserts discloses the claimed invention. 37 C.F.R. § 1.104(c) (requiring the pertinence of each reference to be clearly explained). Moreover, the rejection must contain specific findings explaining that Zoller is supported by the provisional application, as required by Wertheim.

### **REJECTION UNDER 35 U.S.C. § 103**

Claims 49, 50, 51, 56, 57, 58, 67, 69-72, 75 and 76 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over US Patent Publication 20030232407 to Zoller et al, published December 18, 2003 ("Zoller") as set forth above in view of US Patent No. 6383778 to Zuker. However, US Patent No. 6383778 to Zuker constitutes prior art only under 35 U.S.C. 103(e) and should be disqualified under 35 U.S.C. 103(c) as prior art in this rejection under 35 U.S.C. 103(a) because the subject matter which would otherwise be prior art to the claimed invention and the claimed invention are subject to an obligation of assignment to the same organization, at the time the claimed invention was made. Accordingly, the rejection should be withdrawn.

### **STATEMENT PROVIDING EVIDENCE TO ESTABLISH AN OBLIGATION FOR ASSIGNMENT TO THE SAME ORGANIZATION**

Application 09/927,315 and Patent 6383778 were, at the time the invention of Application 09/927,315 was made, both owned by The Regents of the University of California.

## **CONCLUSION**

Withdrawal of the pending rejections and reconsideration of the claims are respectfully requested, and a notice of allowance or entry of an appropriate office action is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicants' representative at (415) 875-2316.

Respectfully submitted,  
CHARLES S. ZUKER ET AL

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By: /Susan T. Hubl/  
Susan T. Hubl, Ph.D., Patent Agent  
Reg. No.: 47,668  
Fenwick & West LLP  
Silicon Valley Center  
801 California Street  
Mountain View, CA 94041  
Tel.: (415) 875-2316  
Fax.: (650) 938-5200